

REMARKS

Claims 1-21 were pending and claims 1-21 stand rejected. By virtue of this response, no claims have been cancelled, no claims have been amended, and no new claims have been added. Accordingly, claims 1-21 are currently under consideration.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Claim Rejections under 35 U.S.C. § 101

Claims 1-21 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Examiner asserts that “[c]laims 1-21 are directed towards method steps, which can be practiced mentally in conjunction with pen and paper, therefore, they are directed to non-statutory subject matter. The claimed methods appear to be directed at software per se that is non-statutory subject matter.”¹

Applicants respectively traverse the rejection and submit that the Examiner appears to be focusing on individual elements of the claims as opposed to the claims as a whole. MPEP § 2106(IV)(C)(2) states that in making the determination of whether a claim complies with 35 U.S.C. § 101, “the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is ‘useful, tangible, and concrete.’” (Emphasis added). Applicants submit that claim 1, taken as a whole, is more than a mere abstract idea and/or mental process, and is clearly drawn to a useful, concrete, and tangible result. For example, independent claim 1 recites a method for performing an Internet search launched from an instant messaging (IM) application, including displaying the sorted search results to the first IM user. At the very least, the act of displaying the sorted search results are a useful, tangible (i.e. not “abstract”), and concrete (i.e. not unrepeatable or unpredictable) result (and clearly not merely a mental step or software per se). Accordingly, the rejection to claim 1 (and claims depending therefrom) must be withdrawn.

¹ It is noted that only claims 1-10 are method claims; however, all claims are addressed herein for completeness.

Independent claims 11 and 21 are also directed to statutory subject matter, e.g., directed to a computer system and an apparatus respectively. In particular, claim 11 recites a computer system comprising, *inter alia*, code for displaying sorted search results to the first IM user. Accordingly, in addition to reciting a computer system, the computer system comprises code for achieving useful, tangible, and concrete results similar to that described for claim 1. Furthermore, claim 21 recites, apparatus configured for “communicating at least one of the sorted results of the search to the first IM user.” Again, the apparatus is configured to achieve a useful, tangible, and concrete result and is therefore directed to statutory subject matter.

Therefore, for at least these reasons, Applicants submit that claims 1, 11 and 21 (and all claims depending therefrom) are drawn to statutory subject matter and the rejections to claims 1, 11, and 21 (and all claims depending therefrom) under 35 U.S.C. § 101 must be withdrawn.

Claim Rejections under 35 U.S.C. § 102

Claims 1-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Jean Pierre De Vries (U.S. Patent No. 6,968,179).

Applicants respectively traverse the rejection and submit that the features of claims 1, 11, and 21 are not disclosed or suggested by De Vries. In particular, De Vries does not disclose or suggest the feature of “providing a first IM user with an option to launch an Internet search of a second IM user directly from the IM application” (emphasis added) as recited in claims 1 and 11 and the feature of “receiving a request from a first IM user for an Internet search of a second IM user, the search request received via user input to the IM application” (emphasis added) as recited in claim 21.

In contrast to the recited features of launching an Internet search of a second IM user directly from an IM application, De Vries discloses providing a user with an option to search for people via “the people/place state data 300 in the database 112 of the information service.” (col. 8, lines 6-26; FIG. 1 and FIG. 4) (Emphasis added). The search in De Vries is not launched directly from an IM application or during an IM conversation. Rather, the search is performed or triggered

before a user contacts his/her friends, for example, “the information service provides notifications to the user when people on the user’s buddy list come within a proximity scope of the user. The user can then [manually] contact the person, such as via cell phone, pager, [or] other electronic messaging.” (col. 10, lines 49-53).

Applicants further assert that since De Vries does not disclose or suggest the feature of “launch[ing] an Internet search” for at least the reasons stated above, De Vries does not disclose the features of “searching the Internet for web pages matching the search query to generate search results using the search server” and “sorting the search results in order of relevance to information in the user profile of the second IM user.” (Emphasis added). Specifically, it is clear that De Vries does not disclose searching the Internet for web pages, and the results of the search are not sorted by relevance to information in the user profile of the second IM user.

It is noted that the Examiner relies on cols. 1 and 2 of De Vries in disclosing the features of “performing an Internet search launched from an instant messaging application” as recited in claims 1, 11, and 21. However, Applicants respectfully submit that this portion of De Vries actually teaches away from the usage of instant messaging services. In particular, De Vries states that instant messaging services “fail to facilitate opportunities for in-person meeting,” (col. 2, lines 1-2) in contrast to “the user-contextual information services based on place and people” (col. 2, lines 14-15) disclosed in De Vries. The Examiner also relies on Figures 2, 3, and 11 of De Vries in disclosing the features of claims 1, 11, and 21. However, Figures 2 and 3 merely disclose a block diagram and a data structure respectively for searching the people/place database 112. There is no indication of an Internet search of a second IM user. Figure 11 shows a user interface screen display, which allows the user to initiate a proximity-based search by selecting a radio button 902 marked “neighborhood.” (col. 16, lines 34-44). Figure 11 shows a radio button marked “web,” however, the user interface screen display is not integrated with an instant messaging application, i.e., it is a separate window, and thus, not launched directly from an IM application as recited.

Accordingly, for at least the above reasons, the rejections to claims 1, 11, and 21 (and all claims depending therefrom) should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 324212008700. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: June 26, 2007

Respectfully submitted,

By 

Christopher B. Eide

Registration No.: 48,375

MORRISON & FOERSTER LLP

755 Page Mill Road

Palo Alto, California 94304-1018

(650) 813-5720